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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,692	08/27/2001	Carine Nizard	15675P364	8653
7590 02/19/2004 Blakely Sokoloff Taylor & Zafman 12400 Wilshire Boulevard 7th Floor Los Angeles, CA 90025			EXAMINER LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/869,692	Applicant(s) NIZARD ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-25, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 11/04/03. Claims pending are 1-35. Claims 1-26 have been amended. Claim 5 has been withdrawn from consideration as directed to non-elected species. Claims 27-35 have been added.

Election/Restrictions

1. Amended Claims 1-21 and 26 and newly submitted claims 27-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 1, as amended, and those dependent thereon are directed to a method of using a composition containing PCO for activating the endogenous synthesis of HSP 32 or a functional peptide fragment thereof, while the original claims were directed to use of PCO for the preparation of a composition intended to activate the endogenous synthesis of HSP 32. Thus, the amended claims are directed to a method of use, while the original claims were directed to a composition or a method of making a composition, depending on interpretation. As discussed in the previous Office Action, the claims were interpreted as directed to a composition. The recitation of intended use of the composition, i.e. "intended to activate the endogenous synthesis of HSP 32", was not given any patentable weight. Even if the original claims had been interpreted as directed to a method for the preparation of the composition, the recitation of the intended use would have not been given any patentable weight. In contrast, the amended claims are directed to a method of *using* the composition, and, therefore, are clearly independent and distinct from the original claims. Inventions related as product and process of use can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or

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(2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the composition of the original claims can be used in a materially different process, such as protecting against solar radiation, skin ageing and as an anticarcinogenic.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-21 and 26-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 22-25, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 22 recites the limitation "cosmetic composition according to Claim 14" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim because Claim 14, as amended, is directed to a method rather than composition. Claims 23, 24, 34 and 35 are rejected because they contain all limitations of Claim 22.

5. Claim 25 provides for the use of the HSP 32 as a cosmetic product, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Accordingly, for the purpose of examination, Claim 25 is being interpreted as directed to a cosmetic product comprising HSP 32.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 22-24, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Levy et al. (WO 95/21018 or its US counterpart 5,780,060).

For the purpose of examination Claim 22 is being interpreted as directed to a cosmetic method for treating skin or integuments in order to protect them against the harmful effects of radiation, comprising the local application to said skin or integuments of an effective amount of at least one cosmetic composition comprising PCO in combination with at least one component chosen from compounds recited in Claim 14.

Levy et al. teach cosmetic protective compositions containing microcapsules prepared from plant polyphenols such as crosslinked grape seed procyanidolic oligomers (PCO). See '060 at Abstract; col. 13, Example 15; col. 20-21, Examples 38-40. PCOs possess anti-free

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radical activity and, therefore, are capable of protecting the skin from harmful effects of solar radiation and ageing, including protecting from erythema. See '060 at col. 1, lines 19-40. The compositions of Levy et al. are applied to the skin. See Examples 39 and 40. Various active substances, such as sunblocks, vitamins (e.g. tocopherol, ascorbic acid esters), liposoluble sunscreens, etc., can be incorporated in the microcapsules. See '060 at col. 5, lines 41-57. The microcapsules can be prepared from a single plant polyphenol or from mixtures of polyphenols including caffeic acid, ellagic acid, curcumin, etc. See '060 at col. 3, lines 63-67; col. 4, lines 1-19.

Thus, Levy et al. teach each and every limitation of Claims 22-24, 34 and 35.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willis et al.

Willis et al. teach HSP 32 protects cell enzymes from inactivation in stressful environments such as heat shock, oxygen radicals, infection, etc. as discussed above. The reference does not explicitly teach cosmetic products containing said enzyme. However, one of ordinary skill would have been motivated to employ HSP 32 of Willis et al. in cosmetic compositions with a reasonable expectation of beneficial results such as protection of the skin against heat and free radicals.

Response to Arguments

10. Applicant's arguments with respect to claims 1-21 and 26 have been considered but are moot in view of the new ground(s) of rejection.

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11. Applicant's arguments with respect to Claim 25 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus, Willis et al. teach the desirability of increasing the concentration of HSP 32 in the cell, but fail to teach a product comprising HSP 32. However, one of ordinary skill would have been motivated to employ HSP 32 of Willis et al. in cosmetic compositions with a reasonable expectation of beneficial results such as protection of the skin against heat and free radicals as suggested by Willis et al.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

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37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618.

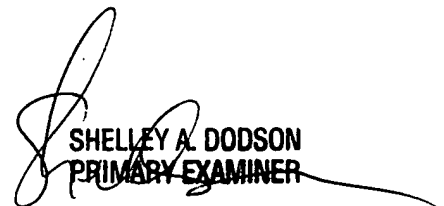
The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ml
2/12/04


SHELLEY A. DODSON
PRIMARY EXAMINER